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EXAMINER	
FRENEL, VANEL	

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/577,386	LESSWING ET AL.	
	Examiner	Art Unit	
	Vanel Frenel	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 24-70* is/are pending in the application.

4a) Of the above claim(s) *12-23, 71-86* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 24-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to the Restriction/Election. Claims 1-11 and 24-70 have been elected. Claims 1-11 and 24-70 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11 and 40-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basic of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

4. Claims 1-11 and 40-52 are rejected under 35 U.S.C.101 because they have only recited a computer implemented method in the preamble of the claims. However, the recitation of a "computer medium" or "system" in the preamble has no patentability weight. Furthermore the body of the claims must also include this feature.

In this present case, the technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-11 and 24-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarter et al (5,704,044) in view of Bosco et al (5.191,522).

(A) As per claim 1, Tarter discloses a computer-implemented method of repricing an electronically received reimbursement claim (Col.13, lines 44-67 to Col.14, line 65) under at least one contract comprising: providing programming code for converting each contract into a plurality of terms and a contract identifier code, each term, of the plurality of terms, containing qualification codes, calculation codes and at least two priority notes, and arranging the plurality of terms, of said contract, into a sequential series of terms (Col.15; lines 7-65); providing programming code for converting the reimbursement claim into a series of claim lines, each claim line containing a claim code, a unit number and a corresponding charge (Col.15, lines 7-67); providing programming code for sequentially comparing each claim code, of the series of claim lines, against each qualification code, of the plurality of terms and when a claim code, of a claim line, is substantially equal to a qualification code, of a term, identifying said term as a matching term associated to said claim line (Col.13, lines 44-67 to Col.14, line 67; Col.15, lines 1-39).

Tarter does not explicitly disclose providing programming code for determining any priority conditions associated to all of the matching terms, and eliminating any matching terms that are excluded by said priority conditions; and providing programming code for determining a reimbursement amount for the claim by processing the calculation codes of the non-eliminated matching terms.

However, these features are known in the art, as evidenced by Bosco. In particular, Bosco suggests providing programming code for determining any priority conditions associated to all of the matching terms, and eliminating any matching terms that are excluded by said priority conditions; and providing programming code for determining a reimbursement amount for the claim by processing the calculation codes of the non-eliminated matching terms (See Bosco, Col.9; lines 1-68; Col.19, lines 58-68 to Col.20, line 68).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Bosco within the system of Tarter with the motivation of providing a system which can operate more efficiently by limiting the access of each application program only to the appropriate data cluster, the entire relational database does not have to be searched while running that program (See Bosco, Col.3, lines 15-23).

(B) As per claim 2, Tarter discloses the computer–implemented method wherein the programming code for determining any priority conditions include: programming code for categorizing the terms, of the sequential series of terms, into pre-defined sections,

wherein the pre-defined sections have a hierarchy that lists a pre-defined section having priority over another pre-defined section prior to said other pre-defined section (Fig.17A; Col.19; lines 40-67 to Col.20; line 38).

(C) As per claim 3, Tarter discloses the computer-implemented method wherein the programming code for determining any priority conditions further include: programming code for arranging the terms, within each pre-defined section, by a reverse hierarchy, which sequential lists a term, having priority over another term, subsequent to said other term (Col.19, lines 40-67 to Col.20; line 38).

(D) As per claim 4, Tarter discloses the computer-implemented method wherein the step of sequentially comparing further includes: when a claim code, of a claim line, is substantially equal to a qualification code of a term, programming code for identifying the pre-defined section in which the term is categorized under as a governing pre-defined section for said claim line (Col.13, lines 44-67 to Col.14, line 67; Col.15, lines 1-39); programming code for sequentially comparing the claim code of said claim line, only against the qualification codes, of each term categorized under said governing pre-defined section (Fig.44A; Col.13, lines 44-67 to Col.14, line 67; Col.15, lines 1-39); and when the claim code of said claim line is substantially equal to a qualification code, of a term categorized under said governing pre-defined section, programming code for identifying said term as a matching term associated to said claim line (Col.13, lines 44-67 to Col.14, line 67; Col.15, lines 1-39).

(E) As per claim 5, Tarter discloses the computer-implemented method wherein the step of determining the reimbursement amount includes: programming code for determining a reimbursement charge for each claim line associated to a non-eliminated matching term (Col.5, lines 38-67 to Col.6, line 31); and programming code for adding the reimbursement charges for said claim lines, whereby the reimbursement amount for the claim is the addition of the reimbursement charges (Col.5, lines 38-67 to Col.6, line 31).

(F) As per claim 6, Tarter discloses the computer-implemented method wherein when a priority note, of a non-eliminated matching term, indicates that the calculation codes, of said non-eliminated matching term, apply to the entire claim, programming code for making the reimbursement amount for the claim equal to the reimbursement charge for the claim line associated to said non-eliminated matching term (Col.5, lines 38-67 to Col.6, line 31).

(G) As per claim 7, Tarter discloses the computer-implemented method wherein when a term, indicates that the calculation codes, of said term, apply to the reimburse amount of the claim, the method further including: programming code for determining the reimbursement amount of said claim (Col.13, lines 44-67 to Col.14, line 65; and when the qualifications of said term are satisfied, programming code for re-calculating the reimbursement amount based upon the calculation codes of said term (Col.13, lines 44-67 to Col.14, line 65).

(H) As per claim 8, Tarter discloses the computer-implemented method wherein the step of converting the claim further includes the step of programming code for associating the claim to a claim identifier code (Col.37, lines 24-67 to Col.38, line 67; Col.44; lines 30-67).

(I) As per claim 9, Tarter discloses the computer-implemented method further including: programming code for comparing the claim identifier code, against the contract identifier code, of each contract, and when the claim identifier code is substantially equal to a contract identifier code, of a contract, identifying said contract as a governing contract, wherein the repricing of said claim is repriced only against said governing contract (Col.13, lines 44-67 to Col.14, line 67; Col.15, lines 1-39).

(J) As per claim 10, Tarter discloses the computer-implemented method wherein the step of repricing the claim against said governing contract further includes: when at least two contracts are identified as governing contracts, programming code for repricing said claim against each governing contract creating a list of governing reimbursement amounts (Col.39, lines 1-67 to Col.40; line 67).

(K) As per claim 11, Tarter discloses the computer-implemented method further comprising: programming code for determining a lowest governing reimbursement amount, of the list of governing reimbursement amounts, wherein the lowest governing reimbursement amount is the reimbursement amount of said claim (Col.44; lines 30-48).

(L) Claim 24 differs from claim 1 by reciting an article of manufacture comprising: a computer usable medium having computer readable program code.

As per this limitation, it is noted that Tarter embodied therein for repricing a reimbursement claim against at least one contract, said claim containing a claim identifier, a plurality of claim lines and a total charge, said contract containing a contract identifier and a plurality of contractual terms, the computer readable program code means in the article of manufacture (Col.1, lines 19-67 to Col.2, line 67; Col.13, lines 44-67 to Col.14, line 65) comprising: computer readable program code means for causing a computer to generate a rate sheet which represents a contract, of the at least one contract, the rate sheet containing one or more rate terms that represent the contractual terms of said contract, and containing a rate identifier code that represents the contract identifier of said contract (Col.13, lines 44-67 to Col.14, line 65); computer readable program code means for causing a computer to generate the claim, the claim having a claim identifier codes and a series of claim lines, each claim line including a claim code, a unit number and a code charge (Col.15, lines 7-67 to Col.16, line 31); computer readable program code means for causing a computer to reprice the claim against a rate sheet, and to generate and assign a reimbursement amount to said repriced claim (Col.15, lines 7-67 toCol.16, line 31) and Bosco discloses computer readable program code means for causing a computer to graphically display the reimbursement amount of the repriced claim, and a difference between the total charge

of the claim and the reimbursement amount of the repriced claim (See Bosco, Col.9; lines 1-67; Col.19, lines 58-67 to Col.20, line 68).

Thus, it is readily apparent that these prior art systems utilize a computer readable program code to perform their specific function.

The remainder of claim 24 is rejected for the same reasons given above for claims 1, and incorporated herein.

(M) As per claim 25, Tarter discloses the article of manufacture wherein the computer readable program code means for causing a computer to generate a rate sheet further includes: computer readable program code means for causing a computer to assign qualification codes, calculation codes and at least one priority note to each rate term, and to arrange said rate terms into a sequential series of terms (Col.13, lines 1-67 to Col.14, line 67; Col.15, lines 1-39).

(N) As per claim 26, Tarter discloses the article of manufacture wherein the computer readable program code means for causing a computer to generate a rate sheet further includes: computer readable program code means for causing a computer to graphically convey the rate sheet by displaying the sequential series of terms in an English language representation (Col.4, lines 8-67 to Col.5, line 37).

(O) As per claim 27, Tarter discloses the article of manufacture wherein the computer readable program code means for causing a computer to generate a rate sheet further

includes: computer readable program code means to generate and display each rate term as a English language paragraph with a series of data entry panels interspersed in the paragraph, the data entry panels prompting a user to define the calculation codes, qualification codes and priority codes for each rate term (Col.4, lines 8-67 to Col.5, line 37).

(P) As per claim 28, Tarter discloses the article of manufacture wherein the computer readable program code means for repricing the claim against a rate sheet further includes: computer readable program code means causing a computer to sequentially compare each claim code, included in the series of claim lines, against each qualification code, of each rate term (Col.4, lines 8-67 to Col.5, line 37; Col.13, lines 1-67 to Col.14, line 35); and when a claim code of a claim line is substantially equal to a qualification code, of a rate term, the computer readable program code means causing a computer to identify said rate term as a matching rate term associated to said claim line (Col.4, lines 8-67 to Col.5, line 37; Col.13, lines 1-67 to Col.14, line 35); computer readable program code means causing a computer to determine any priority conditions associated to the matching rate terms and to eliminate any matching rate terms that are excluded by said priority conditions defining a series of remaining matching rate terms (Col.4, lines 8-67 to Col.5, line 37; Col.13, lines 1-67 to Col.14, line 35); and computer readable program code means causing a computer to compute the reimbursement amount from the calculation codes of the remaining matching rate terms (Col.4, lines 8-67 to Col.5, line 37; Col.13, lines 1-67 to Col.14, line 35).

(Q) As per claim 29, Tarter discloses the article of manufacture wherein the computer readable program code means for causing a computer to generate a rate sheet further includes: computer readable program code means to categorize the rate terms, of the rate sheet, in pre-defined sections, the pre-defined sections have a hierarchy sequence that assigns priority conditions to the rate terms categorized therein (Col.13, lines 1-67 to Col.14, line 35).

(R) As per claim 30, Tarter discloses the article of manufacture wherein the article of manufacture computer readable program code means causing a computer to assign priority conditions to the priority codes of the rate terms categorized within one of the pre-defined sections, said priority conditions defining a priority sequence of said rate terms (Col.13, lines 1-67 to Col.14, line 35).

(S) As per claim 31, Tarter discloses the article of manufacture wherein the computer readable program code means for causing a computer to sequentially compare each claim code further includes: when a claim code, of a claim line, is substantially equal to a qualification code, of a rate term, the computer readable program code means causing a computer to identify the pre-defined section in which the rate term is categorized under as a governing pre-defined section for said claim line (Col.13, lines 1-67 to Col.14, line 35); computer readable program code means causing a computer to sequentially compare the claim code of said claim line, against only the qualification

codes, of each rate term categorized under said governing pre-defined section (Col.13, lines 1-67 to Col.14, line 67); and when the claim code of said claim line is substantially equal to a qualification code, of a term categorized under said governing pre-defined section, the computer readable program code means causing a computer to identify said term as a matching term associated to said claim line (Col.13, lines 1-67 to Col.14, line 67).

(T) As per claim 32, Tarter discloses the article of manufacture wherein the article of manufacture further includes: computer readable program code means causing a computer to compare the claim identifier against the rate identifier code and to identify a rate sheet as a governing rate sheet which has a rate identifier code substantially equal to the claim identifier (Col.15, lines 1-67 to Col.16, line 31); and computer readable program code means causing a computer to reprice the claim only against a governing rate sheet (Col.15, lines 1-67 to Col.16, line 31).

(U) As per claim 33, Tarter discloses the article of manufacture wherein the article of manufacture further includes: when at least two rate sheets are identified as governing rate sheets, computer readable program code means causing a computer to reprice the claim against each governing rate sheet and to create a list of governing reimbursement amounts (Col.14, lines 24-67 to Col.15, line 67; Col.16, lines 1-31).

(V) As per claim 34, Tarter discloses the article of manufacture wherein the article of manufacture further includes: computer readable program code means causing a computer to receive an input from an user to direct the computer to assign either the highest or lowest governing reimbursement amount, from the list of governing reimbursement amounts, as the reimbursement amount of the repriced claim (Col.43, lines 58-67 to Col.44; lines 30-48).

(W) As per claim 35 the article of manufacture wherein the article of manufacture computer further includes : computer readable program code means for causing a computer to store in a repriced claim storage location a repriced claim along with the reimbursement amount of said repriced claim, said repriced claim includes the claim identifier code and claim lines associated to said repriced claim (Col.43, lines 58-67 to Col.44; lines 30-48).

(X) As per claim 36, Tarter discloses the article of manufacture wherein the article of manufacture computer readable program code means for causing a computer to compare the claim identifier code, of a claim, against the claim identifier code, of each repriced claim, stored in the repriced claim storage location; then the claim identifier code, of said claim, is substantially equal to the claim identifier code, of a repriced claim, the computer readable program code means causing a computer to combine the claim lines of said claim with the claim lines of said repriced claim to create a bundled claim (Col.25, lines 60-67 to Col.26; line 67); and computer readable program code means for

causing a computer to reprice the bundled claim and rewrite said repriced claim with the repriced bundled claim (Col.25, lines 60-67 to Col.26; line 67).

(Y) As per claim 37, Tarter discloses the article of manufacture wherein the article of manufacture further includes: computer readable program code means causing a computer to store in a rate sheet storage location the calculation codes, qualification codes and priority codes of a rate sheet (Col.28, lines 1-67 to Col.29, line 67).

(Z) As per claim 38, Bosco discloses the article of manufacture wherein the article of manufacture further includes: computer readable program code means causing a computer to store in a claim storage location the claim lines of a claim (Col.19, lines 33-68 to Col.20, line 59).

(AA) As per claim 39, Tarter discloses the article of manufacture wherein the article of manufacture includes: computer readable program code means causing a computer to store in an identifier storage location a plurality of identifier codes substantially equal to the rate identifier codes, of each rate sheet, and the claim identifier codes, of each claim (Col.37, lines 24-67 to Col.38, line 44); and computer readable program code means causing a computer to logically link each claim having a claim identifier code and each rate sheet having a rate identifier code that are substantially equal to a single identifier code, of the plurality of identifier codes (Col.37, line 1-67 to Col.38, line 67); and computer readable program code means causing a computer to receive inputs from a user, said inputs to

cause the computer to access the identifier storage location and to change an identifier code, of the plurality of identifier codes, whereby each claim and each rate sheet logically linked to said identifier code is automatically changed (Col.37; lines 23-67 to Col.38; Col.39; lines 1-61).

(BB) Claim 40 differs from claims 1 and 24 by reciting (1) each claim containing at least one claim line, each claim line being defined by claim codes, a unit number and a corresponding charge, and (2) each contract containing at least one contractual term.

As per this limitation, it is noted that Tarter discloses a computer-implemented method for repricing a reimbursement claim against under at least one contract (Col.13, lines 44-67 to Col.14, line 65), each contractual term being defined by qualification codes, calculation codes, the method for repricing comprising: comparing each claim code, of the claim, against each qualification code, of each contractual term, of a contract (Col.13, lines 44-67 to Col.14, line 67; Col.15, lines 1-39); when a qualification code, of a contractual term, is satisfied by a claim code, of a claim line, identifying said contractual term as a matching contractual term associated to said claim line, and creating a list of all matching contractual terms (Col.13, lines 44-67 to Col.14, line 67) and Bosco discloses determining any priority conditions associated to the matching contractual terms, and eliminating any matching contractual terms, from said list of matching terms that are excluded by said priority conditions (See Bosco, Col.9; lines 1-67; Col.19, lines 58-67 to Col.20, line 68); and determining a reimbursement charge for each claim line associated to a non-eliminated matching term, and adding the

reimbursement charges for said claim lines, wherein the reimbursement amount for the claim is the addition of said reimbursement charges (See Bosco, Col.9; lines 1-67; Col.19, lines 58-67 to Col.20, line 68).

Thus, it is readily apparent that these prior art systems utilize one contractual term to perform their specific function.

The remainder of claim 40 is rejected for the same reasons given above for claims 1 and 24, and incorporated herein.

(CC) As per claim 41, Tarter discloses the computer-implemented method further comprising: storing each contract on a network contract storage location, the network storage location containing a plurality of contract sets, each contract set associated to a set identifier, each contract further including a contract identifier and a set identifier, wherein each contract containing a set identifier substantially equal to a set identifier of a contract set, is stored within said contract set (Col.2, lines 1-67 to Col.3, line 30); identifying each claim with a set identifier and a claim identifier (Col.3; lines 32-67); comparing the set identifier of a claim against the set identifier, of each contract set, when the set identifier of a claim is substantially equal to the set identifier of a contract set, identifying said contract set as a governing contract set (Col.13, lines 44-67 to Col.14, line 67; Col.15, lines 1-39); comparing the claim identifier of said claim against the contract identifiers of each contract, stored within said governing contract set, and when the claim identifier of said claim is substantially equal to the contract identifier of a contract, stored within said governing contract set, identifying said contract as a

governing contract (Col.2, lines 1-67 to Col.3, line 30); and determining the reimbursement amount of said claim only against said governing contract (Col.3, lines 1-67).

(DD) As per claim 42, Tarter discloses the computer-implemented method wherein the priority conditions further includes: categorizing the contractual terms, of each contract, into a set of sequentially listed pre-defined sections, wherein the pre-defined sections have a hierarchy that lists a pre-defined section, having priority over other pre-defined sections, before said other pre-defined sections (Fig.17A; Col.19; lines 40-67 to Col.20; line 38).

(EE) As per claim 43, Tarter discloses the computer-implemented method wherein the priority conditions further includes: arranging the contractual terms, categorized in each pre-defined section, in a reverse hierarchy, wherein a contractual term having priority over other contractual terms is listed subsequent said other contractual terms (Col.19, lines 40-67 to Col.20; line 38).

(FF) As per claim 44, Tarter discloses the computer-implemented wherein the computer readable program code means for causing a computer to sequentially compare each claim code further includes: when a claim code, of a claim line, is substantially equal to a qualification code, of a contractual term, the computer readable program code means causing a computer to identify the pre-defined section in which the contractual term is categorized under as a governing pre-defined section for said claim line (Col.13, lines 1-67 to Col.14, line 35); computer readable program code means

causing a computer to sequentially compare the claim code of said claim line, against only the qualification codes, of each contractual term categorized under said governing pre-defined section (Col.13, lines 1-67 to Col.14, line 67); and when the claim code of said claim line is substantially equal to a qualification code, of a term categorized under said governing pre-defined section, the computer readable program code means causing a computer to identify said contractual term as a matching contractual term associated to said claim line (Col.13, lines 1-67 to Col.14, line 67).

(GG) As per claim 45, Tarter discloses the computer-implemented method wherein the priority conditions include a claim priority condition which eliminates any matching contractual terms that is listed in a predefined section that is excluded by the claim priority condition (Col.13, lines 44-67 to Col.14, line 67; Col.15, lines 1-39).

(HH) As per claim 46, Tarter discloses the computer-implemented method wherein when one of the priority notes associated to a matching contractual term indicates that said matching contractual term reprices the entire claim, eliminating all other matching contractual terms (Col.5, lines 18-67 to Col.6, line 32).

(II) As per claim 47, Tarter discloses the computer-implemented method wherein the reverse hierarchy is determined by the priority notes associated to each contractual term, categorized in a pre-defined section (Fig.17A; Col.19; lines 40-67 to Col.20; line 67).

(JJ) As per claim 48, Tarter discloses the computer-implemented method wherein the step of repricing further includes: comparing the claim identifier code against the contract identifier code, of each contract, wherein when the claim identifier code is substantially equal to a contract identifier code, of a contract, identifying said contract as a governing contract (Col.2, lines 1-67 to Col.3, line 30); and determining a reimbursement amount of the claim only against the governing contract (Col.3, lines 1-67).

(KK) As per claim 49, Tarter discloses the computer-implemented method wherein the step determining a reimbursement amount for the claim against the governing contract includes: when at least two contracts are identified as governing contracts, repricing said claim against each governing contract creating a list of governing reimbursement amounts, wherein the reimbursement amount of said claim is the lowest governing reimbursement amount (Col.43, lines 58-67 to Col.44; lines 30-48).

(LL) As per claim 50, Bosco discloses the computer-implemented method further including: storing the reimbursement amount of a claim and storing said claim as a repriced claim (Col.19, lines 33-68 to Col.20, line 59).

(MM) As per claim 51, Bosco discloses the computer-implemented method wherein prior to determining the reimbursement amount for a claim the method including: comparing the claim identifier code, of said claim, against the claim identifier codes, of all stored repriced claims (Col.19, lines 33-68 to Col.20, line 59); when the claim

identifier code, of said claim is substantially equal to the claim identifier codes, of a stored repriced claim, combining the claim lines of said claim with the claim line of said repriced claim creating a bundled claim (Col.19, lines 33-68 to Col.20, line 68); determining the reimbursement amount of the bundled claim, instead of determining the reimbursement amount of said claim (Col.9, lines 53-68 to Col.10, line 52); and rewriting the reimbursement amount of the stored repriced claim with the reimbursement amount of the bundled claim and rewriting the stored claim with the bundled claim (Col.19, lines 33-68 to Col.20, line 59).

(NN) As per claim 52, Tarter discloses the computer-implemented method further comprising: tracking the priority conditions associated to the non-eliminated matching terms (Col.5, lines 18-67 to Col.6, line 32); and displaying said priority conditions along with the reimbursement charge of the claim lines associated with said non-eliminated matching terms (Col.3, lines 10-67).

(OO) Claim 53 differs from claims 1, 24, and 40 by reciting computer readable program code embodied therein for configuring a contract.

As per this limitation, it is noted that Tarter discloses an article of manufacture comprising: a computer usable medium containing contractual terms, for repricing a reimbursement claim (Col.1, lines 19-67 to Col.2, line 67; Col.13, lines 44-67 to Col.14, line 65) the computer readable program code means in the article of manufacture comprising: computer readable program code means for causing a computer to

generate a rate sheet representing the contractual terms of said contract, the rate sheet containing identifier codes, and one or more rate terms (Col.13, lines 44-67 to Col.14, line 65) and Bosco discloses a computer readable program code means for causing a computer to arrange the rate terms in a sequential series of terms; and computer readable program code means for graphically conveying the rate sheet by displaying the sequential series of terms in an English language representation (See Bosco, Col.9; lines 1-67; Col.19, lines 58-67 to Col.20, line 68).

Thus, it is readily apparent that these prior art systems utilize computer readable program code embodied therein for configuring a contract to perform their specific function.

The remainder of claim 53 is rejected for the same reasons given above for claims 1, 24 and 40, and incorporated herein.

(PP) As per claim 54, Tarter discloses the article of manufacture wherein the article of manufacture further includes: computer readable program code means to generate and display each rate term as a English language paragraph with a series of data entry panels interspersed in the paragraph, the data entry panels prompting a user to define calculation codes, qualification codes and priority codes for each rate term (Col.4, lines 8-67 to Col.5, line 37).

(QQ) As per claim 55, Tarter discloses the article of manufacture wherein the article of manufacture further includes: computer readable program code means to categorize the rate terms, of the rate sheet, in pre-defined sections, wherein the pre-defined sections

have a pre-defined hierarchy sequence that assigns a priority to the rate terms categorized therein when repricing a claim (Col.43, lines 58-67 to Col.44; lines 30-48).

(RR) As per claim 56, Tarter discloses the article of manufacture wherein the English language paragraph describes the qualification and calculation of the rate term when repricing a medical reimbursement claim (Col.44; lines 30-48).

(SS) As per claim 57, Tarter discloses the article of manufacture wherein the priority codes define a priority sequence to the rate terms within a pre-defined section, of said pre-defined sections (Fig.17A; Col.19; lines 40-67 to Col.20; line 38).

(TT) As per claim 58, Tarter discloses the article of manufacture wherein the article of manufacture further includes: computer readable program code means to permit a user to edit the calculation codes, qualification codes and priority codes of a rate term of the rate sheet (Col.28, lines 1-67 to Col.29, line 67).

(UU) As per claim 59, Tarter discloses the article of manufacture wherein the article of manufacture further includes: computer readable program code means to store a rate sheet, in a data center containing a plurality of networks, each network containing a plurality of rate sheets, similarly configured (Col.2, lines 1-67 to Col.3, line 30); and when the identifier codes of a rate sheet identifier a specific network, of the plurality of

networks, the computer readable program code means stores said rate sheet in the specific network (Col.2, lines 1-67 to Col.3, line 30).

(VV) Claim 60 differs from claims 1, 24 and 53 by reciting a method for electronically representing a reimbursement contract between an insurer and a service provider.

As per this limitation, it is noted that Tarter discloses the method comprising: generating information, stored to computer-readable medium, representing at least one term of said reimbursement contract (See Tarter Col.1, lines 19-67 to Col.2, line 67; Col.13, lines 44-67 to Col.14, line 65) and Bosco discloses associating with said at least one term, information, stored to computer-readable medium (Col.26, lines 35-62), representing at least one qualifier having a corresponding calculation method, wherein the at least one qualifier identifies at least one condition to be satisfied by a claim for reimbursement in order to trigger the corresponding calculation method (Col.20, lines 6-68).

Thus, it is readily apparent that these prior art systems utilize a method for electronically representing a reimbursement contract between an insurer and a service provider to perform their specific function.

The remainder of claim 60 is rejected for the same reasons given above for claims 1, 24, 40 and 53, and incorporated herein.

(WW) As per claim 61, Bosco discloses the method wherein the generated information represents a plurality of terms of said reimbursement contract, further comprising:

associating, with each of said plurality of terms, information, stored to computer-readable medium, representing a priority of such term relative to the other terms (Col.26, lines 35-62).

(XX) As per claim 62, Bosco discloses the method wherein if the corresponding at least one qualifier for multiple ones of the plurality of terms is satisfied by said claim, the priority information is usable to determine the term having the highest priority (Col.20, lines 6-68).

(YY) As per claim 63, Bosco discloses the method wherein the corresponding calculation method for the satisfied at least one qualifier of the term determined to have the highest priority is triggered for computing a reimbursement amount for the claim (Col.20, lines 6-68).

(ZZ) As per claim 64, Bosco discloses the method comprising: associating, with said at least one term, information, stored to computer-readable medium (Col.26, lines 35-62), representing a plurality of different qualifiers that each have a different calculation method associated therewith, wherein each of the different qualifiers identifies a different condition to be satisfied by a claim for reimbursement in order to trigger its respective associated calculation method (Col.20, lines 6-68).

(AAA) Claim 65 differs from claims 1, 24, 40, 53 and 60 by reciting computer-executable software code stored to a computer-readable medium.

As per this limitation, it is noted that Tarter discloses the computer-executable software code comprising: code for defining at least one term of a contract for reimbursement by an insurer (See Tarter, Col.3, lines 10-62) and Bosco discloses code for associating with the at least one term a qualification having a corresponding calculation method, wherein the qualification identifies when a received claim for reimbursement qualifies for reimbursement, under the term with which the qualification is associated, according to the corresponding calculation method (Col.20, lines 6-68).

Thus, it is readily apparent that these prior art systems utilize computer-executable software code stored to a computer-readable medium to perform their specific function.

The remainder of claim 65 is rejected for the same reasons given above for claims 1, 24, 40, 53 and 60, and incorporated herein.

(BBB) As per claim 66, Bosco discloses the computer-executable software code wherein said code for defining at least one term of a contract comprises code defining a plurality of terms of said contract (Col.20, lines 6-68; Col.21, lines 32-68).

(CCC) As per claim 67, Bosco discloses the computer-executable software code further comprising: code for receiving information about a claim submitted for reimbursement

(Col.20, lines 6-26); and code for determining at least one term having a qualification that is satisfied by said claim (Col.20, lines 6-26).

(DDD) As per claim 68, Bosco discloses the computer-executable software code wherein said code for associating comprises: code for associating with a first term of said contract a first qualification having a corresponding first calculation method (Col.20, lines 15-68); and code for associating with said first term of said contract a second qualification having a corresponding second calculation method (Col.20, lines 15-68).

(EEE) As per claim 69, Bosco discloses the computer-executable software code further comprising: code for receiving information about a claim submitted for reimbursement (Col.20, lines 6-68); code for determining whether said first term and its associated first qualification are satisfied by said claim (Col.20, lines 6-68); code for determining whether said first term and its associated second qualification are satisfied by said claim (Col.20; lines 6-68); code for computing a reimbursement amount for said claim according to the first calculation method if said claim satisfies said first term and its associated first qualification (Col.26; lines 6-68); code for computing a reimbursement amount for said claim according to the second calculation method if said claim satisfies said first term and its associated second qualification (Col.26, lines 6-68).

(FFF) As per claim 70, Bosco discloses the computer-executable software code further comprising: code for receiving selection of any one or more attributes of a claim for

reimbursement to be used in defining said at least one term of a contract (Col.26, lines 6-68).

(GGG) Claim 71 differs from claims 1, 24, 40, 53, 60 and 65 by reciting computer-executable software code stored to a computer-readable medium.

As per this limitation, it is noted that Tarter discloses the computer-executable software code comprising: code for generating a user interface providing a phrase describing a term of a contract for reimbursement, wherein said phrase includes at least one input field for receiving input from a user (See Tarter, Col.3, lines 10-62) and Bosco discloses code for generating information, stored to computer-readable medium, representing said at least one term of said reimbursement contract based at least in part on information input to said at least one input field (See Bosco, Col.20, lines 6-68).

Thus, it is readily apparent that these prior art systems utilize computer-executable software code stored to a computer-readable medium to perform their specific function.

The remainder of claim 71 is rejected for the same reasons given above for claims 1, 24, 40, 53, 60 and 65 and incorporated herein.

(HHH) As per claim 72, Bosco discloses the computer-executable software code wherein said contact for reimbursement is a contract for reimbursement by an insurer (Col.20, lines 1-43).

(III) As per claim 73, Bosco discloses the computer-executable software code wherein said phrase includes at least one sentence (Col.21, lines 32-49).

(JJJ) As per claim 74, Bosco discloses the computer-executable software code wherein upon input to said at least one input field, said phrase forms at least one complete sentence (Col.1, lines 32-49).

(KKK) As per claim 75, Bosco discloses the computer-executable software code wherein said at least one input field includes a drop-down menu providing a plurality of choices for selection of input to such field (Col.23, lines 1-44).

(LLL) As per claim 76, Bosco discloses the computer-executable software code wherein said code for generating information representing said at least one term of said reimbursement contract comprises: code for associating, with said at least one term, information, stored to computer-readable medium, representing at least one qualifier having a corresponding calculation method, wherein the at least one qualifier identifies at least one condition to be satisfied by a claim for reimbursement in order to trigger the corresponding calculation method (Col.20, lines 6-68).

(MMM) As per claim 77, Bosco discloses the computer-executable software code wherein said at least one input field receives information corresponding to at least one

of the group consisting of: said at least one qualifier, and said calculation method (Col.20, lines 6-68).

(NNN) As per claim 78, Bosco discloses the computer-executable software code comprising: code for generating output presenting at least one phrase describing terms of the represented contract for reimbursement (Col.20, lines 6-68).

(OOO) As per claim 79, Tarter discloses Computer-executable software code stored to a computer-readable medium, the computer-executable software code comprising: code for defining terms of a contract for reimbursement by an insurer (See Tarter, Col.3, lines 10-62).

Tarter does not explicitly disclose code for generating output presenting at least one phrase describing the terms of the defined contract for reimbursement.

However, this feature is known in the art, as evidenced by Bosco. In particular, Bosco suggests code for generating output presenting at least one phrase describing the terms of the defined contract for reimbursement (See Bosco, Col.20, lines 6-68).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Bosco within the system of Tarter with the motivation of providing a system which can operate more efficiently by limiting the access of each application program only to the appropriate data cluster, the entire relational database does not have to be searched while running that program (See Bosco, Col.3, lines 15-23).

(PPP) As per claim 80, Bosco discloses the computer-executable software code wherein the code for defining said terms of said contract comprise: code for associating, with each of the terms, a qualification having a corresponding calculation method, wherein the qualification identifies when a received claim for reimbursement qualifies for reimbursement, under the term with which the qualification is associated, according to the corresponding calculation method (Col.20, lines 6-68).

(QQQ) As per claim 81, Bosco discloses the computer-executable software code wherein the code for generating output comprises: code for generating output presenting said at least one phrase, wherein said at least one phrase includes at least one sentence (Col.1, lines 32-49).

(RRR) As per claim 82, Tarter discloses a method for generating an electronic representation of a contract for receiving, by a processor-based device, input identifying at least one term of said reimbursement, the method comprising: reimbursement contract, for each of the at least one term, receiving, by said processor-based device, input identifying at least one qualification that specifies at least one condition to be satisfied in a claim for the claim to qualify for reimbursement according to the corresponding contract term (See Tarter, Col.3, lines 32-67).

Tarter does not explicitly disclose for each of the at least one qualification, receiving, by said processor-based device, input identifying a corresponding calculation method.

However, this feature is known in the art, as evidenced by Bosco. In particular, Bosco suggests for each of the at least one qualification, receiving, by said processor-based device, input identifying a corresponding calculation method (Col.20, lines 6-68).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Bosco within the system of Tarter with the motivation of providing a system which can operate more efficiently by limiting the access of each application program only to the appropriate data cluster, the entire relational database does not have to be searched while running that program (See Bosco, Col.3, lines 15-23).

(SSS) As per claim 83, Bosco discloses the method further comprising: said processor-based device representing each of said at least one term of said reimbursement contract by storing to a computer-readable medium the corresponding at least one qualification for each of the at least one term (Col.26, lines 6-68).

(TTT) As per claim 84, Tarter discloses a method for determining a reimbursement amount for a claim, comprising: defining a reimbursement contract in computer-executable program code stored to a computer-readable medium, where said definition of said reimbursement contact includes information associating at least one term of the

contract with at least one qualifier having a corresponding calculation method (See Tarter Col.3, lines 1-67).

Tarter does not explicitly disclose receiving into a processor-based device, information about a claim received for reimbursement, and said processor-based device determining a reimbursement amount for the claim based at least in part on the defined reimbursement contract.

However, this feature is known in the art, as evidenced by Bosco. In particular, Bosco suggests receiving into a processor-based device, information about a claim received for reimbursement, and said processor-based device determining a reimbursement amount for the claim based at least in part on the defined reimbursement contract (See Bosco, Col.20, lines 6-68).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Bosco within the system of Tarter with the motivation of providing a system which can operate more efficiently by limiting the access of each application program only to the appropriate data cluster, the entire relational database does not have to be searched while running that program (See Bosco, Col.3, lines 15-23).

(UUU) As per claim 85, Tarter discloses the method wherein said reimbursement contract comprises a contract between an insurer and a service provider (Col.1, lines 19-64).

(VVV) As per claim 86, Bosco discloses the method wherein said claim for reimbursement is a claim by a medical service provider for reimbursement from an insurer for medical services rendered (Col.2, lines 27-65).

Response to Arguments

6. Applicant's arguments filed on 10/19/04 with respect to claims 1-11 and 24-86 have been fully considered but they are not persuasive.

Applicant's arguments filed 10/19/04 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/19/04.

(A) At pages 1-5 of the 10/19/04 response, Applicant argues the followings:

(1) The Office Action has failed to properly establish that the claims of groups I-III are independent or distinct.

(2) Restriction between Groups I and II is improper. Accordingly, claims 1 and 12 are not drawn to subcombinations that are usable together, but are instead both drawn to repricing methods. The Office Action fails to adequately establish that such a serious burden would arise in the present case if the restriction is not made. Applicants respectfully submit that no serious burden exists if the claims of groups II are not restricted from those of group I, and therefore the restriction requirement as between groups I and II should be withdrawn.

(3) Restriction between Groups I and III is improper. Claim 84 of group III is not drawn to computer-executable code for generating a user interface, but instead directed to a method for determining a reimbursement amount of a claim, similar to those claims of group I. Accordingly, at least claim 84 and claims 85-86 (which depend from claim 84) of group III should not be restricted from the claims of group I.

(B) With respect to Applicant first argument, Examiner respectfully submits that the claims of groups I-III are independent or distinct due to different classes/subclasses that the claim are pertaining to. Furthermore, the distinctiveness of the claims represents a burden for the Examiner since the claims require different searches and therefore the restriction is sustained and Applicant argument is not persuasive and the restriction is hereby made final.

(C) With respect to Applicant second argument, Examiner inadvertently did not mention the restriction due to the fact the claims were previously analyzed and finalized. After a thorough analysis of the claims, Examiner succinctly proposed (or provided a restriction) whereby Applicant provisionally elects claims 1-11 and 24-70 for continued prosecution. Therefore, Applicant argument is not persuasive and the restriction is hereby made final.

(D) With respect to Applicant third argument, Examiner inadvertently consents that a method for determining a reimbursement amount of a claim, similar to those claims of

group I is improper. Due to the clairvoyance and trustworthy of Applicant, Examiner respectfully addressed and analyzed newly added claims 71-86 inclusively and made the restriction final. (See MPEP 810.02 & 810.03).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

January 4, 2005

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